



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/215,095	12/18/98	BECKER	GC507-2

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HM12/0706

EXAMINER
BORIN, M

ART UNIT	PAPER NUMBER
1654	6

DATE MAILED: 07/06/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/215,095

Applicant
Becker et al

Examiner
M. Borin

Group Art Unit
1654



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-56 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-56 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Part III DETAILED ACTION**Restriction Requirement**

The claims are drawn to a granule comprising a protein core, the latter is a mixture of a protein, a sugar, and a structuring agent. The sugar can be a disaccharide or a sugar alcohol. The structuring agent can be a polypeptide or a polysaccharide. There is no common utility disclosed in the claim language. Neither is there any common structural feature disclosed for the sugar or the structural agent as being essential for, undisclosed, utility. Therefore, restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1,2,6-11 (all in part), claim 4; claims 23, 24, 28-33 (all in part), claim 26 drawn to a combination of a protein, a **disaccharide**, and a polypeptide.
- II. Claims 1,2,6-11 (all in part), claims 3,5; claims 23, 24, 28-33 (all in part), claim 25,27, drawn to combination of a protein, a **disaccharide**, and a polysaccharide.
- III. Claims 12,13, 17-22 (all in part),claim15; claims 34,35,39-44 (all in part), claim 37, drawn to combination of a protein, a **sugar alcohol**, and a polypeptide.
- IV. Claims 12,13, 17-22 (all in part),claim14, 16; claims 34,35,39-44 (all in part), claim 36,38, drawn to combination of a protein, a **sugar alcohol**, and a polysaccharide.

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V. Claims 45-50 drawn to method of making a granule.

VI. Claims 51-56 drawn to method of making a granule.

As explained above, the inventions of Groups I-IV are patentably distinct from each other because of the materially different structures of the compositions they are claiming.

Inventions V-VI and I-IV are related as processes of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the methods of Groups V and VI are alternative methods of making the same product.

Inventions V and VI are related as independent methods as they consist of different method steps and are not disclosed as being capable of being used together.

Because these inventions are distinct for the reasons given and have acquired a separate status in the art because of their recognized divergent subject matter, and the necessity for non-coextensive literature searches restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Upon election of any single one of the Groups from above the following election of species is hereby required:

Species Requirement

For the purposes of initial search of the elected invention on the merits, Applicant is requested to elect a single disclosed species for the structural agent (e.g., out of the species given in claims 3-5 for the respective groups), synthetic polymer (e.g., out of the species given in claim 6), and coating (e.g., out of the species given in claim 22).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

To be complete, a response to the election of species requirement should include a proper election along with a listing of all claims readable thereon, including any claims subsequently added.

MPEP 809.02(a).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Woodward who can be reached at (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

MICHAEL BORIN, PH.D
PATENT EXAMINER

June 30, 1999

mlb

